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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,871	07/27/2005	Thomas Goebel	H-32814A	6784
74479 7590 02/07/2008 Novartis Animal Health US Inc. 3200 Northline Avenue, Suite 300 Greensboro, NC 27408			EXAMINER SCHLIENTZ, NATHAN W	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 02/07/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/537,871

### Applicant(s)

GOEBEL ET AL.

### Examiner

Nathan W. Schlientz

### Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/7/05, 7/27/05, 8/11/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-18 were cancelled and claims 19-37 newly added in a preliminary amendment filed 07 June 2005. Claim 29 was amended in a preliminary amendment filed 11 August 2005. Thus, claims 19-37 are pending and are examined herein on the merits for patentability.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) filed 27 July 2005 has been crossed out because the only document listed, Konen et al., is duplicated in the IDS filed 11 August 2005.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 22 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 22 and 30 state "wherein R is  $\text{CH}(\text{C}_3\text{H}_7\text{-n})_2$ ." However, the claims are confusing with regard to the meaning of  $\text{H}_7\text{-n}$ , because there is not a definition for "n".

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2. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 recites the limitation "whereby the two C<sub>2</sub>-C<sub>6</sub> alkyl radicals" in the second to last line of the claim. There is insufficient antecedent basis for this limitation in the claim. Specifically, R is limited to CH(C<sub>2</sub>-C<sub>4</sub> alkyl)<sub>2</sub>, which is more narrow than the limitation "whereby the two C<sub>2</sub>-C<sub>6</sub> alkyl radicals".

3. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 29 recites "radicals are identical and branched or *preferably* unbranched." However, it is confusing whether the recitation of "*preferably* unbranched" is a limitation that requires the alkyl radical to be unbranched. It is suggested that the term "preferably" be deleted from the instant claim.

4. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 37 recites, "the compound of formula as defined in claim 19". However, it is suggested that the claim recite "the compound of formula **(I)** as defined in claim 19".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 19, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,515,754 (Mod et al.).

Mod et al. disclose compositions comprising N,N-disubstituted amides, such as N,N-bis(2-ethoxyethyl)palmitamide, N,N-bis(2-ethoxy)-2-ethylhexanamide, and N,N-bis(2-ethoxyethyl)decanamide (Examples 2, 4 and 10).

It is noted that the recitation of the intended use "vermin-repellent" has not been given patentable weight to distinguish over Mod et al. because the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since Mod et al. discloses compounds that are the same as those claimed, in the absence of evidence to the contrary they would be capable of performing the intended use, as claimed.

2. Claims 19, 23 and 24 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,712,926 (Petersen).

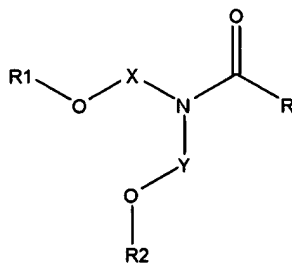
Petersen discloses compositions comprising N,N-disubstituted amides, such as N,N-dimethoxymethylacetamide and N,N-dimethoxymethylpropionamide (Examples 1 and 3).

It is noted that the recitation of the intended use "vermin-repellent" has not been given patentable weight to distinguish over Petersen because the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since Petersen discloses compounds that are the same as those claimed, in the absence of evidence to the contrary they would be capable of performing the intended use, as claimed.

#### ***Allowable Subject Matter***

Claims 20, 21, 25-28 and 31-36 are allowable over the prior art.

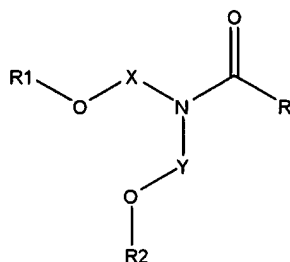
The following is a statement of reasons for the indication of allowable subject matter: Instant claims 29-31 are drawn to compounds of the formula



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wherein R1 and R2 are unbranched or branched C<sub>1</sub>-C<sub>12</sub> alkyl, which is unsubstituted or substituted by halogen, cyano or nitro; X and Y, independently of one another, are a straight-chain or branched alkylene bridge with 1 to 20 carbon atoms, which is unsubstituted or substituted by halogen, cyano or nitro; and R is CH(C<sub>2</sub>-C<sub>4</sub> alkyl)<sub>2</sub>, whereby the two C<sub>2</sub>-C<sub>4</sub> alkyl radicals are identical and branched or unbranched.

Instant claims 19-28 are drawn to vermin-repellent compositions comprising compounds of the formula



wherein R1 and R2 are unbranched or branched C<sub>1</sub>-C<sub>12</sub> alkyl, which is unsubstituted or substituted by halogen, cyano or nitro; X and Y, independently of one another, are a straight-chain or branched alkylene bridge with 1 to 20 carbon atoms, which is unsubstituted or substituted by halogen, cyano or nitro; and R is branched or unbranched C<sub>1</sub>-C<sub>15</sub> alkyl; and at least one appropriate diluent or a spreading additive.

Instant claims 32-36 are drawn to a method for deterring or repelling vermin from an animal; a human, or an object comprising applying the compound of claim 29 or the composition of claim 19 to said animal, human or object.

Compounds of the closest prior art include N,N-bis(2-ethoxyethyl)palmitamide, N,N-bis(2-ethoxy)-2-ethylhexanamide, and N,N-bis(2-ethoxyethyl)decanamide as disclosed by U.S. Patent No. 3,515,754 (Mod et al.), and N,N-

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dimethoxymethylacetamide, and N,N-dimethoxymethylpropionamide as disclosed by U.S. Patent No. 3,712,926 (Petersen). However, neither Mod et al. nor Petersen disclose, teach, or reasonably suggest compounds wherein R, as represented in the formulas above, is  $\text{CH}(\text{C}_2\text{-C}_4 \text{ alkyl})_2$ , whereby the two  $\text{C}_2\text{-C}_4$  alkyl radicals are identical and branched or unbranched.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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